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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,075	02/12/2002	Yoshikazu Yamaguchi	P 290700 D1119	3126

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EXAMINER

BERMAN, SUSAN W

ART UNIT	PAPER NUMBER
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1711

3

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,075

Applicant(s)

YAMAGUCHI ET AL.

Examiner

Susan W Berman

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: .

Art Unit: 1711

Claim Rejections - 35 USC § 101 and § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of the word "type" in line 8 "oligomer-type" in claim 1 and in claims 5 and 6 renders the claims indefinite because it is not clear whether applicant intends to recite an oligomeric initiator or a different kind of initiator of the same type as an oligomer. Claim 7 provides for the use of the resin composition of claim 1, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 7 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102/35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1711

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/12942.

WO '942 discloses reactive silica particles treated with an organic compound corresponding to the compound set forth in instant claims 2-4 and compositions comprising the particles. Photoinitiators are taught on pages 30-31. Applicant defines "oligomer-type" photoinitiators as having a molecular weight of 400 to 10,000 on page 19 of the instant specification. The photoinitiators disclosed by WO '942 fall within the molecular weight range set forth and are therefor considered to meet the requirement for an "oligomer-type" photoinitiator in the instant claims.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/12942, as applied to claims 1-5, 7 and 8 above, and further in view of Li Bassi et al (4,672,079). WO '942 teaches using a photoinitiator that generates activation radicals by radiation, preferably UV light. The examples taught do not include the photoinitiator set forth in instant claim 6. Li Bassi et al teach polymeric or polymerizable aromatic-aliphatic ketones of formula (I), encompassing photoinitiators of the formula set forth in instant claim 6, suitable as polymerization initiators for the photopolymerization of ethylenically unsaturated monomers or prepolymers. Li Bassi et al teach that the disclosed photoinitiators have high efficiency in regard to the useful concentration required and to the polymerization rate and have other advantages (column 2, line 57, to column 3, line 2). Li Bassi et al teach that the polymeric photoinitiators can be used with traditional photoinitiators, such as those taught by WO '942 (column 4, lines 60-66).

It would have been obvious to one skilled in the art at the time of the invention to employ the polymeric photoinitiators taught by Li Bassi et al as the photoinitiator in the compositions disclosed by WO '942. Alternatively, It would have been obvious to one skilled in the art at the time of the invention

Art Unit: 1711

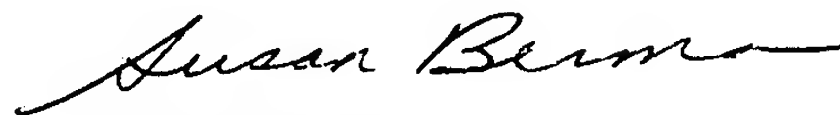
to employ the polymeric photoinitiators taught by Li Bassi et al in combination with the photoinitiators disclosed by WO '942 in the compositions disclosed by WO '942. WO '942 provides motivation by teaching that a photoinitiator that generates radicals by radiation is preferred. WO '942 does not limit the photoinitiator to those set forth as examples. Li Bassi et al provide motivation by teaching the advantages of using the polymeric photoinitiators disclosed. One of ordinary skill in the art at the time of the invention would have been motivated to employ the polymeric photoinitiators disclosed by Li Bassi et al by an expectation of taking advantage of the higher polymerization rate than conventional photoinitiators and of obtaining products that do not yellow under UV light or sunlight and other advantages taught by Li Bassi et al.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 703 308 0040. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703 308 2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9310 for regular communications and 703 872 9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0661.



Susan W Berman
Primary Examiner
Art Unit 1711

SB
March 20, 2003